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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 580,515	05 25 2000	Jay M. Short	DIVER1370-4	9360

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FISH & RICHARDSON, PC
4350 LA JOLLA VILLAGE DRIVE
SUITE 500
SAN DIEGO, CA 92122

EXAMINER

RAMIREZ, DELIA M

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 03 25 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/580,515

Applicant(s)

SHORT ET AL.

Examiner

Delia M. Ramirez

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a) in no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b)

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18 and 41-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 18 and 41-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Status of the Application

Claims 18 and 41-79 are pending.

Applicant's amendment of claims 18, 41-43, 51, 55-59, 67 and addition of new claims 72-79, in Paper No. 14, filed on 1/13/2003 is acknowledged.

Applicant's supplemental amendment of claims 18, 46, 52-53, 62, 68-69, 73-75, 77-79 in Paper No. 15, filed on 1/25/2003 is acknowledged.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 2/20/2003 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Double Patenting

2. Claims 18, 41-79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6183740.
3. This rejection, which was discussed at length in Paper No. 13, mailed on 10/11/2002, was applied to claims 18, 41-71 and is now applied to newly added claims 72-79 for the reasons of record.

4. Applicants argue that claims 1-5 of U.S. Patent No. 6183740 are patentably distinct from the claims in the instant application. Applicants direct the Examiner's attention to a communication mailed on September 21, 2001, which according to Applicants, stated that ten inventions were present and that an election was required. Applicants assert that they elected group IV with traverse in Paper No. 7. Applicants also assert that an Office Action mailed March 27, 2002 indicated that the restriction requirement was final. Accordingly, Applicants argue that claims 1-5 of U.S. Patent No. 6183740 are drawn to an invention that is distinct from the current pending claims.

5. Applicant's arguments have been fully considered but are not deemed persuasive to overcome the rejection. It is unclear to the Examiner as to which communication is being referred to by Applicants. The claims in U.S. Application No. 09/318528, which issued as U.S. Patent No. 6183740, were not restricted. The first Office Action on the merits was a Notice of Allowance accompanied by an Examiner's amendment, mailed to Applicants on 6/6/2000 according to PTO records. It is also noted that U.S. Patent No. 6183740 issued on 02/06/2001, which is several months before the mailing date of the communication (9/21/2001) referred to by Applicants. As indicated in previous Office Action Paper No. 13, if upon availability of the parent application No. 08/910798, it was determined that the double patenting rejection was improper due to a restriction requirement, the rejection would be withdrawn. According to PTO records, the claims in U.S. Application No. 08/910798, which issued as U.S. Patent No. 5876997 were restricted in 4 groups as follows: (1) claims 1, 16-17, drawn to a phytase, (2) claims 2-9, 13, drawn to a DNA encoding a phytase, (3) claims 10-12, drawn to an antibody against phytase, (4) claims 14-15, drawn to a method of phytate hydrolysis. This restriction corresponds to Paper

No. 7, mailed to Applicants on 5/18/1998. Therefore, in view of the restriction requirement as set forth in Paper No. 7, the double patenting rejection applied to claims 18, 41-79 of the instant application is proper and it is maintained for the reasons of record.

6. Claims 18, 41-79 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of copending Application No. 09777566.

7. Claims 18, 41-79 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 18 of copending Application No. 09/866379.

8. These rejections, which were discussed at length in Paper No. 13, mailed on 10/11/2002, were applied to claims 18, 41-71 and are now applied to newly added claims 72-79 for the reasons of record.

9. Applicants request that since these are provisional rejections, this issue be held in abeyance until the instant claims have been found in condition for allowance.

10. Since a terminal disclaimer has not yet being filed and no arguments have been presented pointing out disagreements with the Examiner's contentions, the double patenting rejection is maintained for the reasons of record.

Conclusion

11. No claim is in condition for allowance.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Applicants are requested to submit a clean copy of the pending claims (including amendments, if any) in future written communications to aid in the examination of this application.

14. Certain papers related to this application may be submitted to Art Unit 1652 by facsimile transmission. The FAX number is (703) 308-4556. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If Applicant submits a paper by FAX, the original copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (703) 306-0288.

The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (703) 308-3804. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Delia M. Ramirez, Ph.D.
Patent Examiner
Art Unit 1652

DR
March 20, 2003


HEIDI M. J. J. J. J.
PRIMARY EXAMINER
GROUP 1000
1600